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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,491	01/27/2001	Raymond Anthony Joao	RJ180	7937

7590 04/06/2007  
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EXAMINER
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VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/771,491	<b>Applicant(s)</b> JOAO, RAYMOND ANTHONY	
	<b>Examiner</b> John Van Bramer	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 81-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 81-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on November 15, 2006, cancelled claims 61-80 and claims 81-100 were added. Previous amendments cancelled claims 1-60. Thus, the currently pending claims in the applications are Claims 81-100.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 81-100 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:
  - a. In regards to independent claim 81, the applicant has disclosed the following meets and bounds:
    - i. A merchant requests advertising space. This request triggers an event that is detected by a processing device. The processing device generates a message regarding the event and transmits the message to a content provider. The content provider receives the message and responds to processing

device with a request to create an affiliated marketing relationship with the merchant. The processing device then processes the message.

- ii. The processing device establishes the affiliated marketing relationship between the content provider and the merchant and stores information regarding the affiliated marketing relationship in a database.

However, there is no disclosure as to how the processing device is able to establish the affiliated marketing relationship between the content provider and the merchant. As currently claimed, the processing device has merely received and processed the response by the content provider. It would be necessary for the processing device to send some type of message to the merchant indicating the content providers request for an affiliated marketing relationship and the merchant must respond to the message in order for the processor to accomplish the claimed step of establishing the affiliated marketing relationship between the two entities. Claims 82-100 suffer from the same deficiency by virtue of dependence.

4. Claims 83-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 83 recites "receiving a query

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regarding an available at least one of an advertisement space" from the merchant. However, Claim 81 from which it depends is limited to one response from the merchant. That response is a request from the merchant to create an affiliated marketing relationship. The examiner is unclear as to whether the applicant is indicated that the request to create an affiliated marketing relationship contains the disclosed query, in which case there is an antecedent basis issue, or whether the applicant is trying to extend the functionality disclosed in Claim 81 and thereby altering the metes and bounds of the claim. The same type of issue occurs when the applicant attempts to claim that a second message is generated in response to the query. Claim 81 limits the functionality of the invention to the merchant receiving a notification of an event and responding with a request to create an affiliated marketing relationship. The processor is only disclosed as being capable of receiving and processing the message followed by establishing the relationship and storing the information. New functionality can not be added to the processor without altering the metes and bounds of claim 81. This issue may be capable of being corrected by adding the omitted method steps mentioned above or by creating an antecedent basis with the step of processing disclosed in claim 81 such as; wherein said processing the second step includes the generation of a second message. Claims 84-100 suffer from the same antecedent basis problems regarding the processing of information, or the generation queries as disclosed for Claim 83.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 81-87, 92-93, 96-97, and 99 are rejected under 35 U.S.C. 102(e) as being anticipated by Capek (U.S. Patent Number: 6,026,369).

Claim 81: Capek discloses a computer-implemented method, comprising :

- a. Receiving a first request by a content provider to be notified regarding an occurrence of an event, wherein the event is at least one of a request by a merchant for advertising space, a change in an offered price for an advertising space, and a change in a term or condition for an advertising offering. (Col 3, lines 1-15)
- b. Detecting the occurrence of the event, wherein the occurrence of the event is automatically detected with a processing device. (Col 3, lines 1-15)
- c. Generating a message containing information regarding the event, wherein the processing device automatically generates the message. (Col 3, lines 15-39)

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- d. Transmitting the message to a computer or a communication device associated with the content provider. (Col 3, lines 15-39)
- e. Receiving a second request to create an affiliated marketing relationship between the content provider and a merchant associated with the event, which was automatically detected, wherein the second request is transmitted from the computer or the communication device associated with the content provider. (Col 3, lines 31-65)
- f. Processing the second request, and establishing the affiliated marketing relationship between the content provider and the merchant. (Col 3, lines 31-65)
- g. Storing information regarding the affiliated marketing relationship in a database or a memory device. (Col 3, line 40 through Col 5, line 7)

Claim 82: Capek discloses the computer-implemented method of Claim 81, wherein the message is transmitted to the computer or the communication device in real-time. (Col 3, lines 15-39)

Claim 83: Capek discloses the computer-implemented method of Claim 81, further comparing:

- a. Receiving a query regarding an available at least one of an advertisement apace, an advertisement rate, a commission, a referral fee, and a term or condition of an advertisement offering, wherein the query is transmitted from a second computer or a second communication device, wherein the second computer or the second

communication device is associated with the merchant. (Fig. 3, and Col 3, line 1 through Col 4, line 7)

- b. Processing the query and generating a second message in response to the query, wherein the second message includes information regarding at least one of an advertisement space, an advertisement rate, a commission, a referral fee, and a term or condition of an advertisement offering. (Col 3, line 1 through Col 4, line 7)
- c. Transmitting the second message to the second computer or the second communication device. (Col 3, line 1 through Col 4, line 7)

Claim 84: Capek discloses the computer-implemented method of Claim 81, further comprising: processing information regarding a purchase of an advertisement space or an advertisement service. (Col 3, lines 9-12) (The arrival of a placement request is information regarding a purchase.)

Claim 85: Capek discloses the computer-implemented method of Claim 81, further comprising: processing information regarding a bid for an advertisement space or an advertisement service. (Col 3, lines 9-12 and Col 3, lines 25-65) (When the system processes the content providers responses regarding the number of its customers that satisfy the placement request, is it bidding to provide the requested service with the disclosed number of placements)



Claim 86: Capek discloses the computer-implemented method of Claim 81, further comprising: processing information regarding an auction of advertisement space or an advertisement service. (Col 3, lines 9-12 and Col 3, lines 25-65) (When the disclosed bids are received the system determines the winner of the auction and sends the chosen winners information regarding the number allocated placements they have been chosen to provide.)

Claim 87: Capek discloses the computer-implemented method of Claim 81, further comprising:

- a. Receiving a query regarding an available at least one of an advertisement space, an advertisement rate, a commission, a referral fee, a term or condition of an advertisement offering, and an affiliated marketing relationship, wherein the query is transmitted from a second computer or a second communication device, wherein the second computer or the second communication device is associated with the merchant. (Col 3, lines 25-65)
- b. Processing the query and generating a second message in response to the query, wherein the second message includes information regarding at least one of an advertisement space, an advertisement rate, a commission, a referral fee, and a term or condition of an advertisement offering. (Col 3, lines 25-65)
- c. Transmitting the second message to the second computer or the second communication device. (Col 3, lines 25-65)

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Claim 92: Capek discloses the computer-implemented method of Claim 81, further comprising: storing information regarding a past success rate of an advertisement and a success rate of the content provider. (Col 3, line 66 through Col 4, line 8)

Claim 93: Capek discloses the computer-implemented method of Claim 81, further comprising: processing information regarding a web site or a link visited, utilized, or navigated, by an individual or a user in connecting to a computer or a web site associated with the merchant. (Col 3, line 66 through Col 4, line 8)

Claim 96: Capek discloses the computer-implemented method of Claim 81, wherein the first request is transmitted on or over at least one of the Internet and the World Wide Web. (Col 1, lines 5-20)

Claim 97: Capek discloses the computer-implemented method of Claim 81, wherein the message is transmitted on or over at least one of the Internet and the World Wide Web. (Col 1, lines 5-20)

Claim 99: Capek discloses the computer-implemented method of Claim 81, further comprising: providing notification to the content provider of the occurrence of a transaction pursuant to the affiliated marketing relationship. (Col 3, line 25 through Col 4, line 7)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 88-91, 94-95, 98 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capek (U.S. Patent Number: 6,026,369).

Claims 88-91, 94, 95: The computer-implemented method of Claim 81. While Capek is silent regarding the manner in which the content provider and central processor node is remunerated for providing and placing the advertisements, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the central processing system charge the advertiser a fee for its services and to pay the content provider utilizing a commission structure based upon the number of placements each content provider performed. The motivation for the central processor to determine and pay the content provider based upon a commission structured on the number of placements is found in Capek Col 2, lines 14-44 and Col 3, lines 40-65. Capek discloses that the central processing node receives requests for ad placement. The ad placement requests contain the number of placements an advertiser requires. The central processor queries the content providers to determine if the entire placement can be accommodated. The

central processor may break down the number of placements into smaller increments and choose content providers to provide placements based upon matching the smaller increment with the number of possible placements each content provider has pledged to provide. Since the Capek disclosure indicates that these smaller increments can be of various sizes such as 2000 placements for one content provider and 8,000 placements for another content provider. Given the varied nature of the placements for each provider, a commission structure pay scheme in which content provider's are paid based upon placements is motivated. Additionally, since the central processing node is the only entity in direct communication with the advertiser and in possession of the entire advertiser placement request it would be expected that the central processing node administer the charge to the advertiser.

Claims 98 and 100: The computer-implemented methods of Claims 81 and 99, further comprising:

- a. Processing information regarding a transaction pursuant to the affiliated marketing relationship. (Col 3, line 25 through Col 4, line 7)
- b. Generating a transaction notification report containing information regarding the transaction. (Col 3, line 25 through Col 4, line 7)
- c. Transmitting the transaction notification report to the computer or the communication device associated with the content provider. (Col 3, line 25 through Col 4, line 7)

While Capek is silent regarding the manner in which the content provider and central processor node is remunerated for providing and placing the advertisements, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the central processing system charge the advertiser a fee for its services and to pay the content provider utilizing a commission structure based upon the number of placements each content provider performed, and thus dictate the reporting of transactions and the resulting payments for account purposes. The motivation for the central processor to determine and pay the content provider based upon a commission structured on the number of placements is found in Capek Col 2, lines 14-44 and Col 3, lines 40-65. Capek discloses that the central processing node receives requests for ad placement. The ad placement requests contain the number of placements an advertiser requires. The central processor queries the content providers to determine if the entire placement can be accommodated. The central processor may break down the number of placements into smaller increments and choose content providers to provide placements based upon matching the smaller increment with the number of possible placements each content provider has pledged to provide. Since the Capek disclosure indicates that these smaller increments can be of various sizes such as 2000 placements for one content provider and 8,000 placements for another content provider. Given the varied nature of the placements for each provider, a commission structure pay scheme in which content provider's are paid based upon placements is motivated. Additionally, since the central processing node is the only entity in direct

communication with the advertiser and in possession of the entire advertiser placement request it would be expected that the central processing node administer the charge to the advertiser.

### ***Response to Arguments***

9. Applicant's arguments with respect to newly submitted claims 81-100 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*jvb*  
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